

|| HAEBERLI  
Application No.: 09/684,595  
Page 6

PATENT

## REMARKS

The Office Action mailed November 20, 2003 finally rejected claims 1-9, 11-15, 17-19 and 21 under 35 U.S.C. 103(a) as being unpatentable over Oles (6,047,130) and Dawson (5,179,638). Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Oles (6,047,130) in view of Dawson and Kurashige (5,282,262). Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (5,870,771) in view of Oles and Dawson.

Applicants respectfully traverse the rejections and respectfully submit that all claims are in condition for allowance.

### The Section 103 Rejections

Applicants respectfully traverse the rejection of the claims over Oles and Dawson. Applicants respectfully traverse the rejection since Oles and Dawson, singly or in combination, cannot render the invention obvious.

In Oles, all appearances used "size perspective" for video image. Column 2 line 1 of Oles states "The present invention overcomes these deficiencies by providing a method and apparatus that allows a customer to visually determine the appropriate size of a portrait photograph and matching picture frame by displaying upon a portrait display viewer a perspective view of a combined video image of the photograph and the matching frame within a simulated room image." Further, Column 5 line 31-35: "The present invention as depicted in FIG. 5 allows the customer or operator to change the perspective of the video image (and the size of the resulting portrait) as well as move and position the combined image within the simulated room setting image." This is further supported by the fact that all Oles figures show a frontal view of the picture. The fact that the monitor showing the simulated picture(s) is shown in a 3D perspective view further supports the contention that the "perspective view" in Oles is not the perspective view as claimed.

In sum, the "perspective" term in Oles relates to the "size of the resulting portrait". In contrast, in the present invention, page 6 provides a discussion of the "perspective view":

A "perspective frame image" is an image that shows an in-perspective view of a frame. In other words, the frame in such a perspective frame image is not shown in a head-on view. For example, a frame can be arranged in a typical scene in which the frame might be displayed (e.g., on a table) and then a digital camera can be used to capture a perspective image of the frame as it appears in the scene. Also, a white piece of paper (or other suitable material) can be

HAEBERLI

Application No.: 09/684,595  
Page 7PATENT

mounted in the frame where an image print would be displayed. As a result, the perspective frame image will include a white region located where an image print would be visible in the frame (also referred to here as the "picture area"). An example of such a perspective frame image 300 having a picture area 302 is shown in FIG. 3A.

As shown above, Oles only shows a head-on view and does not show the perspective view.

Dawson is a hardware reference and there is no suggestion in the software system of Oles to incorporate the texture hardware. As amended, Oles and Dawson fail to show at least the modifying a texture value at a pixel by the original pixel value of the picture image to generate the frame prototype image. The office action points to Oles' Fig. 4 26 to Fig. 5 26 as showing the modification of the texture value at a pixel by the original pixel value of the picture image to generate the frame prototype image. However, the description of Fig. 4 fails to show this aspect, among others. As noted in Oles:

Once satisfied with the combined image and referring now to FIG. 4, the customer can select a particular simulated room setting image 28 for displaying the combined image. The customer/operator scrolls through a series of simulated room setting images such as dens, living rooms, libraries, or bedrooms to find an image suitable for displaying the combined image. Like the picture frame images, the present invention includes previously stored images of simulated room settings for later retrieval. After selecting the simulated room setting image 28, the present invention combines the combined picture frame image 26 and video image 24 with the selected simulated room setting image as depicted in FIG. 4 to produce a simulated perspective room image. As previously stated, the present invention initially transposes the video image as a 5".times.7" image; and when combined with the room image, the video image appears in a perspective view of the room image to produce a simulated perspective room image. In other words, the combined video and picture frame image appears to the customer on video portrait viewer 20 in a perspective view as 5".times.7" picture would appear in the selected room setting. Upon seeing the perspective view, the customer can immediately determine whether the size of the portrait is correct, whether the picture frame matches the portrait, and whether the combined portrait and picture frame will match the selected room. The present invention as depicted in FIG. 5 allows the customer or operator to change the perspective of the video image (and the size of the resulting portrait) as well as move and position the combined image within the simulated room setting image. If for some reason, the customer does not want a picture frame, the present invention will work equally as well in displaying a video image of a portrait in a simulated perspective room image without a picture frame bordering the video image. Additionally, the present invention allows the customer to view one or more video images, with or without the picture frame image combination, in combination with the simulated room setting image so that the customer can see a perspective view of multiple portraits in a simulated room.

|| HAEBERLI

Application No.: 09/684,595  
Page 8PATENT

The above section in Oles compels the conclusion that Oles does not discuss the modifying a texture value at a pixel by the original pixel value of the picture image to generate the frame prototype image, among others. Dawson is similarly lacking.

Based on the foregoing, Applicant respectfully traverses the Section 103(a) rejection. Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on all of the above requirements.

Here, the Office Action fails to establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Moreover, the prior art references fail to teach or suggest all the claim limitations. Here, neither Oles, Dawson nor Kurashige shows at least the texture mapping element. Withdrawal of the Section 103 rejection on claim 10 is requested.

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (5,870,771) in view of Oles and Dawson. Again, the Office Action fails to establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Moreover, the prior art references fail to teach or suggest all the claim limitations. Here, neither Oles, Dawson nor Oberg shows at least the modifying a texture value at a pixel by the original pixel value of the picture image to generate the frame prototype image. Withdrawal of the Section 103 rejection on claim 16 is requested.

In sum, since the references do not show at least the texture mapping in connection with the other elements in the independent claims, Applicants submit that the references cannot

HAEBERLI

Application No.: 09/684,595  
Page 9PATENT

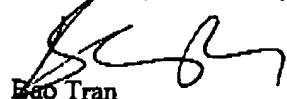
anticipate or render obvious any of the independent claims. The dependent claims are allowable since they depend from allowable independent claims.

## CONCLUSION

Please charge any required fees to Deposit Account

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

  
Bao Tran

Reg. 37,955